

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant	:	Larry Stevens)	
)	
Appl. No.	:	09/228,325)	
)	
Filed	:	January 11, 1999)	Group Art Unit: 3711
)	
Title	:	SYSTEM AND METHOD)	
		FOR BONDING AN ACRYLIC)	
		SURFACE TO A FRAME)	
)	
Examiner	:	Michael S. Chambers)	
)	
Confirm. No.:	:	8737)	
)	
Customer No.	:	22,913)	

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On July 10, 2006, Applicant timely filed a Notice of Appeal from the Final Office Action mailed February 9, 2006. Applicant appeals the rejection of all of the pending claims.

This Appeal Brief complies with the requirements set forth in 37 C.F.R. § 41.37 and is accompanied with the fee under 37 C.F.R. § 41.20(b). The Commissioner is authorized to charge payment of any additional fees associated with this communication, which have not otherwise been paid, to Deposit Account No. 23-3178. If any additional extension of time is required, which have not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

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I. Real Party in Interest

The real party in interest is Lifetime Products, Inc., the assignee of record.

II. Related Appeals and Interferences

This application, serial no. 09/228,325, was the subject of Appeal No. 2002-0980, which was heard on February 19, 2003. A decision was rendered by the Board on March 27, 2003 and it reversed the decision of the examiner finally rejecting the appealed claims.

A copy of the Board decision is included in the appendix as required by 37 C.F.R. §41.37(c)(1)(x).

III. Status of Claims

The Final Office Action dated February 9, 2006 rejected Claims 1, 2, 5-18 and 44-53, which are all the pending claims.

Specifically, the Office Action rejected Claims 1, 2, 5, 6, 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093. The Office Action rejected Claims 44-53 in view of the Claim 1 rejection discussed above. Claims 2, 5-18, and 50-53 were also rejected under Section 103(a).

Applicant appeals the rejection of all the pending claims, Claims 1, 2, 5-18 and 44-53.

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IV. Status of Amendments

No Response to the Final Office Action mailed on February 9, 2006 was filed. Thus, Applicant believes the claims remain as amended in the Amendment and Response to Office Action filed on December 1, 2005.

V. Summary of Claimed Subject Matter

By way of background, the presently claimed invention is directed to an acrylic basketball backboard assembly sized and configured for playing the game of basketball. Prior to the present invention, acrylic basketball backboards were bonded to a backboard frame structure with double-sided tape. See, e.g., page 2, lines 3-8; see also U.S. patent no. 5,839,982 issued to Hying, et al., col. 2, lines 13-16. Manufacturing acrylic basketball backboard assemblies with double-sided tape is very labor intensive. See, e.g., page 2, lines 9-14. Furthermore, such acrylic backboard assemblies are subject to occasional adhesive failure.

The presently claimed basketball backboard assembly includes a basketball backboard frame structure and an acrylic backboard which are bonded together with a catalyzed elastomeric adhesive. See, e.g., page 2, lines 22-27; page 3, lines 9-10.

The claimed elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball. See, e.g., page 1, lines 21-25; page 3, lines 15-17. Silicone adhesive is a currently preferred elastomeric adhesive because of its excellent adhesion and flexibility and low cost. See, e.g., page 2, line 27; page 3, lines 1-2; claim 14.

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Appellant found that the bond gap affects adhesion and flexibility. A currently preferred adhesive bond gap may range from about 2 to 2.5 mm. See, e.g., page 3, lines 23-24; claims 2 and 18. A bond gap spacer positioned between the frame bonding surface and the acrylic backboard may be used to control the adhesive bond gap. A variety of different bond gap spacers can be used to control the adhesive bond gap. A variety of different bond gap spacers can be used such as spherical beads, including glass microspheres and plastic beads, and weed trimmer line. See, e.g., page 4, lines 2-4; page 6, lines 6-11; claims 7, 8, 9, 14, 16 and 17. Glass microspheres having a diameter in the range from about 2 to 2.5 mm (0.08 to 0.1 inch) function very well. See, e.g., page 6, lines 8-10; claims 10 and 18. The bond gap spacer should have a rigid structure of the desired thickness which can maintain the gap between the frame and backboard bonding surface. See, e.g., page 6, lines 3-6.

The elastomeric adhesive may be a two-part catalyzed adhesive in which the two parts are combined in a ratio to provide a set time in the range from about 5 minutes to 1 hour, and more preferably from about 7 to 15 minutes. See, e.g., page 6, lines 21-24; claims 5, 6, 14 and 15.

A. Independent Claim 1

Independent Claim 1 is directed to a basketball backboard assembly that is sized and configured for playing the game of basketball. See, e.g., page 1, lines 5-9; page 2, lines 22-24. The basketball backboard assembly comprises a basketball backboard frame structure having a bonding surface and an acrylic basketball backboard having a bonding surface. See, e.g., page 4, lines 16-20.

A catalyzed elastomeric adhesive is sandwiched between the frame bonding surface and the backboard bonding surface. See, e.g., page 4, lines 20-21; page 4, line 25; page 6, lines 17-18; page

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10, lines 19-20. The elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball. See, e.g., page 10, lines 25-26.

B. Independent Claim 14

Independent Claim 14 is directed to a basketball backboard assembly that is sized and configured for playing the game of basketball. See, e.g., page 1, lines 5-9; page 2, lines 22-24. The basketball backboard assembly comprises a metal basketball backboard frame structure having a bonding surface and an acrylic basketball backboard having a bonding surface. See, e.g., page 4, lines 16-20. A catalyzed silicone adhesive sandwiched between the frame bonding surface and the backboard bonding surface. See, e.g., page 4, lines 20-21; page 4, line 25; page 6, lines 17-18; page 10, lines 19-20. The silicone adhesive is configured to provide a set time in the range from about 5 minutes to 1 hour. See, e.g., page 3, lines 13-14; page 6, lines 22-24. The silicone adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball. See, e.g., page 10, lines 25-26. One or more bond gap spacers located between the frame bonding surface and the backboard bonding surface to provide the bond gap. See, e.g., page 3, line 25 to page 4, line 2; page 6, lines 1-3.

C. Independent Claim 44

Independent Claim 44 is directed to a basketball backboard assembly comprising a basketball backboard frame and a basketball backboard constructed from acrylic. See, e.g., page 2, lines 22-24;

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page 4 ,lines 12-14. A catalyzed silicone-based adhesive connects the basketball backboard and the basketball backboard frame and is positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame. See, e.g., page 4, lines 20-21; page 4, line 25; page 6, lines 17-18; page 10, lines 19-20.

D. Independent Claim 46

Independent Claim 46 is directed to a basketball backboard assembly comprising a basketball backboard frame and a basketball backboard. See, e.g., page 2, lines 22-24; page 4, lines 12-14. A catalyzed elastomeric adhesive connects the basketball backboard and the basketball backboard frame and is positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame. See, e.g., page 4, lines 20-21; page 4, line 25; page 6, lines 17-18; page 10, lines 19-20.

E. Independent Claim 48

Independent Claim 48 is directed to a basketball backboard assembly comprising a basketball backboard frame and a basketball backboard. See, e.g., page 2, lines 22-24; page 4, lines 12-14. A catalyzed elastomeric adhesive connects the basketball backboard and the basketball backboard frame and is positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame. See, e.g., page 4, lines 20-21; page 4, line 25; page 6, lines 17-18; page 10, lines 19-20.

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F. Independent Claim 50

Independent Claim 50 is directed to a basketball backboard assembly comprising a basketball backboard frame and a basketball backboard. See, e.g., page 2, lines 22-24; page 4, lines 12-14. A silicone-based adhesive connects the basketball backboard and the basketball backboard frame and is positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame. See, e.g., page 4, lines 20-21; page 4, line 25; page 6, lines 17-18; page 10, lines 19-20.

G. Independent Claim 52

Independent Claim 52 is directed to a basketball backboard assembly comprising a basketball backboard frame and a basketball backboard. See, e.g., page 2, lines 22-24; page 4, lines 12-14. A silicone-based adhesive connects the basketball backboard and the basketball backboard frame and is positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame. See, e.g., page 4, lines 20-21; page 4, line 25; page 6, lines 17-18; page 10, lines 19-20. One or more bond gap spacers positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame to provide a defined bond gap. See, e.g., page 3, line 25 to page 4, line 2; page 6, lines 1-3.

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VI. Grounds of Rejection to be Reviewed on Appeal

Issue 1: Did the Examiner fail to establish a *prima facie* case of obviousness of independent Claims 1, 14, 44, 46, 48, 50 and 52 where there is no teaching, suggestion or motivation recognizable by one of ordinary skill in the relevant art to combine the cited prior art references?

Issue 2: Whether Claims 1, 2, 5-18 and 44-53 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; Dow Corning Data Sheet Q3-6093; Official Notice taken by the Examiner; and Ichemco.

(a) Whether Claims 1, 2, 5, 6, 14 and 15 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; Dow Corning Data Sheet Q3-6093.

(b) Whether Claims 7-13 and 16-18 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093 in view of Official Notice.

(c) Whether Claims 44 and 45 are unpatentable under 35 U.S.C. § 103(a) over

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applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.

(d) Whether Claims 46 and 47 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.

(e) Whether Claims 48 and 49 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.

(f) Whether Claims 50 and 51 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.

(g) Whether Claims 52 and 53 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622

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issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedelecki, et al.; and Dow Corning Data Sheet Q3-6093.

(h) Whether Claims 50-53 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of Ichemco, web page downloaded on 6/24/05, <http://www.ichemco.it/ENG/tab/siliconepsa.asp> (cited by Examiner Chambers in non-final Office Action mailed on July 1, 2005).

VII. Argument

A. Issue 1: Did the Examiner fail to establish a *prima facie* case of obviousness of independent Claims 1, 14, 44, 46, 48, 50 and 52 where there is no teaching, suggestion or motivation recognizable by one of ordinary skill in the relevant art to combine the cited prior art references?

The initial burden is on the Examiner to present evidence from which it can be concluded that a *prima facie* case of obviousness has been established. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1976), cert. denied, 389 U.S. 1057 (1968); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Here, the Examiner has not met his initial burden because there is no teaching, suggestion or motivation in the combined teachings of the cited references.

In fact, this appeal raises the same issue decided in Appeal No. 2002-0980, which was an earlier appeal by Applicant for this same application. In this earlier appeal, the Board reversed the decision of the examiner finally rejecting the appealed claims because the examiner failed to

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establish a *prima facie* case of obviousness.

Once again, the examiner has cited various prior art references that disclose isolated claim elements but failed to establish *prima facie* obviousness because there is no teaching, suggestion or motivation to combine the references to arrive at the claimed invention. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so.” MPEP § 2143.01 (citing In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006)); see also In re Rouffet, 149 F.3d 1350, 1357, (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obviousness was improper.). Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 (citing In re Mills, 916 F.2d 680 (Fed. Cir. 1990)).

In this case, the cited prior art fails to suggest the desirability of the claimed combination. As discussed below, the cited references disclose a ball with unpredictable bounce characteristics (U.S. patent no. 6,056,622 issued to Chung); a hockey stick with a flexible net for catching and stopping a puck in both the forehand and backhand position (U.S. patent no. 3,809,401 issued to Hankele); and a safety tip of a water sport board, such as a surf board, for reducing or preventing injury to a user upon impact with the nose portion of the board (U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedelecki, et al.). Significantly, none of these cited references teach, suggest or disclose replacing double-sided adhesive tape with silicone adhesive. These cited references also do not teach, suggest or disclose using a silicone adhesive to bond an acrylic basketball backboard to a basketball

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backboard frame. Further, these cited references do not teach, suggest or disclose using an adhesive that “provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.”

The cited Dow Corning Data Sheet Q3-6093 also does not teach, suggest or disclose using silicone adhesive instead of double-sided tape in any application. In addition, the Dow Corning Data Sheet Q3-6093 does not teach, suggest or disclose that silicone adhesive is “equivalent” to double-sided tape for any application. Further, the Dow Corning Data Sheet Q3-6093 does not teach, suggest or disclose that the silicone adhesive can bond an acrylic basketball backboard to a basketball backboard frame or that it “provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.”

The cited prior art merely shows various elements of the claimed invention, but fails to suggest the desirability of the claimed invention. Here, the Examiner appears to take the position that because some type of adhesive was previously used in connection with sporting goods unrelated to basketball backboards, it would have been obvious to substitute silicone adhesive for double-sided tape to attach a basketball backboard to a basketball backboard frame. The Examiner also appears to conclude that it would have been obvious to try any number of prior art adhesives until one possibly arrived at a successful result. Merely because double-sided tape and adhesives were known does not mean that it would have been obvious to replace one with the other. “There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination” and “[t]hat knowledge cannot come from the applicant’s invention itself.” In re Oetiker, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

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The cited references do not teach, suggest or disclose replacing the double-sided tape of a basketball backboard assembly with an adhesive to achieve the unique properties and advantages disclosed by Applicant. The cited references also provide no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful if an adhesive is used. Thus, the cited references fail to teach, suggest or disclose the claimed invention.

In addition, the Examiner has not pointed out where the cited references teach using the particular adhesive of the Dow Corning Data Sheet Q3-6093. In contrast, the Examiner merely makes the unsupported allegations that “those knowledgeable in the sporting goods adhesion art were aware of silicon adhesives and their suitability and advantages when considering cost, cushioning and superior adhesive qualities where sporting goods will be used under severe conditions, such as outdoors.” See Final Office Action dated 02/09/2006 at page 3. Moreover, the Examiner has not pointed out where the cited references teach using the particular adhesive of Dow Corning Data Sheet Q3-6093 would “lower production costs and manufacture a more durable backboard in order to increase the player’s satisfaction with the product.” Id. Because the Examiner has not provided any evidence to support these statements, they cannot support a finding of obviousness.

In summary, none of the cited references provide any teaching, suggestion or motivation to replace the double-sided tape with an adhesive, much less the particular adhesive disclosed in Dow Corning Data Sheet Q3-6093, to bond a basketball backboard and a basketball backboard frame. Thus, the Examiner has not established a *prima facie* case of obviousness of independent Claims 1, 14, 44, 46, 48, 50 and 52.

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The Examiner also makes various statements such as “no unexpected or extraordinary results were obtained by applicant in using the silicone adhesive” or “it is not apparent that there is any criticality in the type of silicon adhesive used.” See Final Office Action dated 02/09/2006 at pages 3-7. Applicant, however, in specifically disclosing the type of adhesive used in the invention, has made clear that this adhesive has been chosen for its excellent adhesive and flexibility, controllable cure time, adaptability to automated assembly, etc. See, e.g., specification, pages 2-4. These matters are at the very heart of Applicant’s disclosed and claimed invention, and these features cannot be simply ignored or brushed aside. See Appeal No. 2002-0980, page 8.

B. Issue 2: Whether Claims 1, 2, 5-18 and 44-53 are unpatentable are unpatentable under 35 U.S.C. § 103(a) over applicant’s admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedelecki, et al.; Dow Corning Data Sheet Q3-6093; Office Notice taken by the Examiner and Ichemco.

Patentability depends on whether one of ordinary skill in art would have thought it obvious at the time to combine the individual elements in the matter claimed. See In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.”). Patentability does not depend on whether the invention can be broken into individual elements found in the prior art. Section 103(a) demands more. In particular, there must be some teaching, suggestion or motivation to combine prior art references to render the invention as a whole obvious. See In re Adams, 356 F.2d 998, 1001-002 (CCPA 1966).

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In this case, the technology is a relatively simple mechanical device that most people have seen or used before—a basketball backboard. Because this technology is relatively straight forward, Section 103(a) must be carefully applied. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351 (Fed. Cir. 2001) (“When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the test of whether to combine references need to be applied rigorously.”).

In addition, specific identification and analysis of the teaching, suggestion or motivation to combine the references must be provided, otherwise the inventor’s disclosure may be used “as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” In re Dembiczak, 175 F.3d 994, 994 (Fed. Cir. 1999) (“the best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). In particular, the examiner must provide a reasoned basis to explain why the conclusion of obviousness is correct. See In re Kahn, 441 F.3d 977, 987 (Fed. Cir. 2006) (“rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). Thus, legal determinations of obviousness should be based on evidence rather than on mere speculation or conjecture.

The examiner, however, based his obviousness analysis on broad, conclusory statements without any specific findings that one of ordinary skill in the art would have combined the cited references in the manner claimed without knowledge of the invention. In particular, while the references cited by the Examiner may disclose various elements of the claims, none of the cited

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references provide any teaching, suggestion or motivation to do the following: (1) replace double-sided adhesive tape with silicone adhesive for a basketball backboard; (2) use silicone adhesive to bond an acrylic basketball backboard to a basketball backboard frame; or (3) use an adhesive that “provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The cited references are discussed in more detail below.

1. U.S. Patent No. 6,056,622 issued to Chung

In contrast to the Examiner’s assertion, the Chung patent does **not** disclose that the “attachment of sports articles can be secured by suitable and conventional means” which includes using “silicone glue.” Instead, the Chung patent discloses:

The **parts of ball part 60** are thereafter **secured together by suitable and conventional means, such as an adhesive like clear silicone glue with a chemical composition, methoxy polydimethylsiloxane, which is thereafter allowed to cure about one day and at room temperature.**

Col. 4, lines 28-32 (emphasis added).

In greater detail, the Chung patent discloses a ball with unpredictable bounce characteristics. In particular, the Chung patent states the ball part 60 comprises a ball of the high bouncing type, such as ball 30 of Figure 1. Col. 3, lines 65-67. The Chung patent explains:

Ball part 30 comprises a **conventional high bouncing type ball** of the type that might also be utilized to play, practice or train with for **baseball**. Ball part 30 is made of an **elastic rubber** (silicone, thermoplastic elastomer, or the like) and is referred to as high bouncing because when dropped from a height of 149 cm onto a marble floor, ball 30 will rebound at about 112 cm.

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Col. 3, lines 21-27 (emphasis added).

Thus, the Chung patent discloses a conventional high bouncing type ball that may be used to play baseball and is constructed from elastic rubber. The Chung patent also discloses that parts of the elastic rubber, high bouncing type ball may be secured together using an adhesive like clear silicone glue, which is allowed to cure about one day and at room temperature. Therefore, the Chung patent teaches using an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball.

In contrast, Claim 1, for example, is directed towards a basketball backboard assembly including a frame and an acrylic backboard. In addition, Claim 1 positively recites “a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Chung patent, on the other hand, discloses using an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball. The Chung patent does **not** teach, suggest or disclose either: (1) using clear silicone glue to adhere a backboard frame and an acrylic backboard; or (2) that the silicone glue will provide sufficient adhesion and flexibility to an acrylic backboard and frame structure that will allow it to be used in the game of basketball. Accordingly, the Chung patent does **not** teach, suggest or disclose each and every element of Claim 1.

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2. U.S. Patent No. 3,809,401 issued to Hankele

The Hankele patent discloses a hockey stick with a flexible net for catching and stopping a puck in both the forehand and backhand position. Col. 1, lines 41-43. In particular, the Hankele patent states that the hockey stick includes a handle 12, a blade 14 and a net 16. The Hankele patent also states “[a] rod 18 extends across the elbow between the handle 12 and the blade 14. Rod 18 has one end 20 that is secured in a hole adjacent the toe 22 of blade 14. A second end 24 of the rod is secured in a hole in handle 12. The ends 20 and 24 are secured in place by a pressed fit, or if desired, an adhesive can be used to additionally secure the ends in place.” Col. 2, lines 12-18 (emphasis added). The Hankele patent further states “[t]he net 16 has an upper edge that is secured to the rod 18. This securement is accomplished by forming loops 26 in the top strands of the net, and adhesively securing these loops to the rod 18.” Col. 2, lines 23-26 (emphasis added). Additionally, the Hankele patent states “[t]he net also includes free ends 28 which are secured in holes in the handle 12 and blade 14. The free ends 28 are adhesively secured in place within the holes.” Col. 2 lines 26-29 (emphasis added). The Hankele patent states “[t]he rod 18, the loops 26 and the ends 28 of the net 16 can be adhesively secured in place by any of the adhesives known in the art, such as epoxy or silicone adhesives.” Col. 2, lines 34-37 (emphasis added).

Accordingly, the Hankele patent discloses that adhesives known in the art, such as epoxy or silicone adhesives, may be used to: (1) additionally secure the ends of a rod 18 that are press fit into a hole in the toe of the blade and into a hole in the handle of a hockey stick; (2) adhesively secure loops 26 in the top strands of a net 16 to the rod 18; and (3) adhesively secure the free ends 28 of the net 16 in holes in the handle 12 and blade 14. Therefore, the Hankele patent teaches using adhesives

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that are known in the art, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, secure loops in the top of a net to a rod, and secure the free ends of the net into holes in the hockey stick.

Claim 1, for example, positively recites, inter alia, “a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Hankele patent does **not** teach, suggest or disclose, for example, a catalyzed elastomeric adhesive sandwiched between a frame bonding surface and a backboard bonding surface, or an elastomeric adhesive that provides sufficient adhesion and flexibility to an acrylic backboard and frame structure bonding surface to be used in the game of basketball. Accordingly, the Hankele patent does **not** teach, suggest or disclose each and every element of Claim 1.

3. U.S. Patent Nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.

The Skedleski patents are directed towards a safety tip of a water sport board, such as a surf board, for reducing or preventing injury to a user upon impact with the nose portion of the board. For example, the ‘316 patent states “a surfboard tip cover is provided which comprises a generally hollow, substantially V-shaped member which is made of a relatively soft, flexible and resilient silicone material.” Col. 1, lines 33-37 (emphasis added). The ‘316 patent also states “[t]he tip cover is preferably constructed of a flexible and resilient liquid injected silicone.” Thus, the Skedleski

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patents are directed towards a relatively soft, flexible and resilient silicone material that is used that is used as a safety device.

The Skedleski patents also state that “[t]he tip cover is fixedly secured to the top portion of the board, for example, by silicone adhesive between the body portion and the extension portions and the parts of the board that they overlay.” Col. 1, lines 55-59 of the ‘314 patent. The ‘316 patent states that “[i]t is preferable that any space left between the tip of the board and the apex of the cover be filled with the silicone adhesive to provide an even further cushioning effect.” Col. 2, lines 59-63.

Thus, the Skedleski patents disclose using a silicone adhesive to attach the relatively soft, flexible and resilient silicone tip cover to the sharply pointed nose of a water sport board. The Skedleski patents also disclose that any space between the tip of the board and the apex of the cover may be filled with silicone adhesive to provide an even further cushioning effect. Therefore, the Skedleski patents disclose using a silicone adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board as a safety device.

In contrast, Claim 1, for example, is directed towards a basketball backboard assembly including a frame and an acrylic backboard. Additionally, Claim 1 positively recites, inter alia, “a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Skedleski patents do **not** teach, suggest or disclose, for example, a catalyzed elastomeric adhesive sandwiched between a frame bonding surface and an acrylic backboard bonding

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surface. In addition, the Skedleski patents do **not** teach suggest or disclose an elastomeric adhesive that provides sufficient adhesion and flexibility to an acrylic backboard and frame structure bonding surface to be used in the game of basketball. Accordingly, the Skedleski patents do **not** teach, suggest or disclose each and every element of Claim 1.

Sub-Issue (a): **Whether Claims 1, 2, 5, 6 14 and 15 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; Dow Corning Data Sheet Q3-6093.**

None of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 1, 2, 5, 6, 14 or 15. For example, none of the cited references disclose a **basketball backboard assembly sized and configured for playing the game of basketball**. In contrast, the cited references disclose a ball with an unpredictable bounce, a hockey stick, and a water sport board safety tip. Thus, Claims 1, 2, 5, 6, 14 and 15 are not unpatentable under Section 103(a).

In addition to none of the cited references teaching, suggesting or disclosing a basketball backboard assembly sized and configured for playing the game of basketball, none of the cited references teach, suggest or disclose either a **backboard frame structure having a bonding surface** or an **acrylic backboard having a bonding surface**. In fact, none of the cited references disclose any type of basketball related structures or are even used in connection with basketball. Thus, Claims 1, 2, 5, 6, 14 and 15 are not unpatentable under Section 103(a)..

In addition to none of the cited references teaching, suggesting or disclosing a basketball

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backboard assembly sized and configured for playing the game of basketball, a backboard frame structure having a bonding surface or an acrylic backboard having a bonding surface; none of the cited references teach, suggest or disclose **a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface** or an **elastomeric adhesive providing sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball**. As discussed above, none of the cited references are used in connection with basketball. Because none of the references teach, suggest or disclose a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface or the elastomeric adhesive providing sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball, Accordingly, Claims 1, 2, 5, 6, 14 and 15 are not unpatentable under Section 103(a).

Further, there is **no suggestion** that any of the cited references can be properly combined to support this Section 103 (a) rejection. As discussed above, the courts have made clear that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. See, e.g., ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In this case, there is no teaching, suggestion or incentive to combine an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball; an adhesive, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, to secure loops in the top of a net to a rod, and to secure the free ends of the net into holes in the hockey stick; and/or a safety device that uses a silicone adhesive to attach a relatively soft, flexible and

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resilient silicone material to the hard, sharp point of a water sports board. Accordingly, Claims 1, 2, 5, 6, 14 and 15 are not unpatentable under Section 103(a) because there is no teaching, suggestion or incentive supporting the combination of these references.

Furthermore, the cited references **teach away** from Claim 1 which positively recites “a catalyzed elastomeric adhesive that is sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” For example, the cited references disclose using: (1) an adhesive to secure together parts of an elastic rubber, high bouncing ball; (2) an adhesive to further secure the ends of a rod into holes in a hockey stick, to secure loops in the top of a net to a rod, and to secure the free ends of the net into holes in the hockey stick; and (3) an adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board. Thus, the cited references teach using an adhesive to connect **different materials** for **different purposes** than the claimed basketball backboard assembly. Therefore, because the cited references **teach away** from the claimed invention, this Section 103 (a) rejection is inappropriate.

In addition to Claims 1, 2, 5, 6, 14 and 15 not being obvious in view of the cited art, the **secondary considerations of nonobviousness confirm that the claimed invention is not obvious.**¹

As stated in the MPEP:

Objective evidence or secondary considerations such as unexpected results, commercial success, longfelt need, failure of others, copying by others, licensing,

¹ See MPEP § 716.01(a) at 700-255 (8th ed. rev. 2 2004) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983)).

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and skepticism of experts are relevant to the issue of obviousness and **must be considered in every case** in which they are present. When evidence of any of these secondary considerations is submitted, **the examiner must evaluate the evidence.**²

Such secondary considerations may serve to “establish that [the] invention appearing to have been obvious in light of the prior art was not.”³ In fact, evidence of commercial success may be so strong that it requires a reversal of a decision that the teachings of the prior art would have suggested the claimed invention to one of ordinary skill in the art.⁴ Here, the secondary considerations of commercial success and copying by others confirm that the invention is not obvious.

a. The Claimed Invention has Enjoyed Great Commercial Success

In his declaration, Mr. Jerry Ward explained that the Assignee Lifetime Products has had great commercial success selling the claimed invention. Mr. Ward stated:

As Manager of Boards, Silk Screen, and Materials, I am aware of the materials and manufacturing costs associated with fabricating acrylic basketball backboards. Lifetime products saves approximately \$3 per backboard in material costs for each acrylic backboard fabricated using catalyzed elastomeric adhesive instead of conventional two-sided tape. **In the year 2000, Lifetime Products manufactured approximately 300,000 acrylic backboard basketball systems.** This represents a materials cost savings of about \$900,000. **In the year 2001, Lifetime Products is projected to manufacture approximately 400,000 acrylic backboard basketball systems.**⁵

Thus, in 2000, Assignee Lifetime Products manufactured about 300,000 acrylic backboards using

² See MPEP § 2141 at 2100-121 (8th ed. rev. 2 2004).

³ *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1498 (Fed. Cir. 1986), *cert. dismissed*, 483 U.S. 1052 (1987).

⁴ See *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1577 (Fed. Cir. 1984), *cert. denied*, 471 U.S. 1065 (1985).

⁵ Ward Decl. ¶ 11, dated August 31, 2001 (Filed with an Amendment and Response to Office Action mailed on September 11, 2001).

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catalyzed elastomeric adhesive to attach the acrylic backboard to the frame. In 2001, Assignee Lifetime Products was projected to manufacture about 400,000 such acrylic backboards. The selling of approximately 700,000 acrylic backboards using catalyzed elastomeric adhesive to attach the acrylic backboard to the frame in a two year period demonstrates definite commercial success. This strong evidence of commercial success shows that the prior art would not have suggested the claimed invention to one of ordinary skill in the art.

b. Commercial Success is Based At Least in Part on the Significant Material and Labor Costs Savings Caused by the Claimed Invention

Mr. Ward also explained that the claimed invention has resulted in significant reductions in the costs of materials for each basketball backboard constructed using a catalyzed elastomeric adhesive:

As Manager of Boards, Silk Screen, and Materials, I am aware of the materials and manufacturing costs associated with fabricating acrylic basketball backboards. **Lifetime products saves approximately \$3 per backboard in material costs for each acrylic backboard fabricated using catalyzed elastomeric adhesive instead of conventional two-sided tape.** In the year 2000, Lifetime Products manufactured approximately 300,000 acrylic backboard basketball systems. **This represents a materials cost savings of about \$900,000.** In the year 2001, Lifetime Products is projected to manufacture approximately 400,000 acrylic backboard basketball systems. **This represents a materials cost savings of about \$1,200,000.**⁶

Thus, Assignee Lifetime Products saved approximately \$2,100,000 in material costs during the two year period of 2000-01.

Mr. Ward further explained that using the claimed invention over the conventional two-sided

⁶ Ward Decl. ¶ 11, dated August 31, 2001 (Filed with an Amendment and Response to Office Action mailed on September 11, 2001).

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tape resulted in a labor savings of about 62.5%:

There are very significant labor savings when acrylic backboards are fabricated using catalyzed elastomeric adhesive. Using twelve (12) people in three shifts, about 2400 acrylic backboards may be fabricated per day using the catalyzed elastomeric adhesive process. In contrast, twenty-four (24) people in three shifts are required to fabricate 1800 acrylic backboards using the conventional two-sided tape system. This represents labor savings of about 62.5%.⁷

Thus, by employing embodiments of the claimed invention, the Assignee had great commercial success, significant reductions in materials costs, and a tremendous savings in labor costs.

c. Others Have Copied the Claimed Invention

Huffy Sports is a direct competitor of Lifetime Products, the assignee of this application, and sells basketball backboards. As discussed below, Huffy Sports copied the claimed invention after Assignee Lifetime Products began selling its backboard and enjoying its great commercial success.

(1). In 1999, after Six Years of Using the Conventional Double-Side Tape Systems, Assignee Began Using the Claimed Invention

Mr. Ward explained that Lifetime Products, the assignee of the present application, began using the conventional double-sided tape systems in 1993:

Lifetime Products began manufacturing and selling acrylic basketball backboards in 1993 using two-sided foam tape to secure acrylic basketball backboards to a backboard frame.⁸

Mr. Nye added that Lifetime Products began selling embodiments of the claimed invention in October 1999:

⁷ Ward Decl. ¶ 12 (August 31, 2001).

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In October 1999, Lifetime Products began selling acrylic basketball backboards fabricated with elastomeric adhesive to bond the acrylic backboard to the frame. Prior to this, Lifetime Products used double-sided tape to fabricate acrylic basketball backboards.⁹

(2). In 2001, Huffy Sports Copied the Claimed Invention

In his declaration, Mr. S. Curtis Nye explained how Huffy Sports previously used the conventional double-sided tape systems: “Huffy Sports utilized double-sided tape to bond the acrylic backboard to the frame.”¹⁰

Mr. Nye then explained that in 2001, Lifetime Products learned that Huffy had switched to using the claimed invention:

Lifetime Products recently became aware of two commercially available acrylic basketball backboards manufactured by Huffy Sports, a division of Huffy Corporation, that utilize an elastomeric adhesive to bond the acrylic backboard to the frame. These are a metal frame unit, model number 9H909, and a blow molded frame unit, model 74069. Lifetime Products purchased these products for evaluation in July and August 2001. ***Prior to this time***, Huffy Sports utilized double-sided tape to bond the acrylic backboard to the frame.¹¹

Thus, the claimed invention has been copied by others.

Thus, the secondary considerations of nonobviousness confirm that the claimed invention is not obvious. For example, the claimed invention has enjoyed great commercial success by selling millions of dollars of product within a two year period. In addition, the claimed invention has resulted in significant cost and labor savings. Further, the claimed invention was promptly copied by

⁸ Ward Decl. ¶ 3 (August 31, 2001).

⁹ Nye Decl. ¶ 2 (August 31, 2001).

¹⁰ Nye Decl. ¶ 3 (August 31, 2001).

¹¹ Nye Decl. ¶ 3 (August 31, 2001) (emphasis added).

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other so that they could enjoy some of the commercial success, material costs savings and reduction in labor caused by the claimed invention.

In summary, the claimed invention is not obvious because Lifetime Products and Huffy Sports both used conventional double-sided tape systems for years. However, once Lifetime Products developed the claimed invention, it immediately enjoyed commercial success and significant savings in both material and labor costs. Huffy Sports then promptly copied the claimed invention. Accordingly, the secondary considerations of nonobviousness confirm that the claimed invention is not obvious. Consequently, this Section 103 (a) rejection of Claims 1, 2, 5, 6, 14 and 15 is inappropriate.

d. **Prior Decision by the Board Held that the Claimed Invention was Not Obvious in View of Similar References**

On March 27, 2003, the Board reversed the examiner's previous final rejection of the claims under Section 103(a). The examiner primarily relied upon U.S. patent no. 5,839,982 issued to Hying, et al., and the Dow Corning adhesive to support his obviousness rejection.¹² The Board, however, found no teaching or suggestion (not even an inference) that would have motivated one of ordinary skill in the art to use the Dow Corning adhesive to attach Hying's basketball backboard and basketball frame:

Like appellant, *we find no teaching, suggestion, or inference* in the combined teachings of the applied references that would have led the ordinarily skilled artisan **to utilize the adhesive of Dow Corning to secure the acrylic backboard of Hying to the backboard frame**, as proposed by the examiner. The examiner's position to the effect that it would have been an "obvious choice" for one of ordinary skill in the art

¹² See *Ex parte Stevens*, 4-5, 9 (Bd. Pat. App. & Inter. March 27, 2003) [Paper No. 26].

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to use any readily available and suitable adhesive, and in particular the adhesive of Dow Corning, as a replacement for Hying's double-sided adhesive is without foundation in the absence of evidence supporting such contention. ***More particularly, the examiner has not pointed out where the applied references teach that using Dow Corning's adhesive in Hying's environment would "prevent injury to the player," and/or precisely what "properties over wide temperature ranges" Dow Corning's adhesive possesses that the one of ordinary skill in the art would have found to be "desirable" in Hying's environment.***¹³

Thus, no reference taught or suggested the Dow Corning adhesive could be used in the Hying patent's particular "environment" of attaching its basketball backboard to its basketball frame. Accordingly, without the proper teaching or suggestion, it was improper to hold that it was obvious to use the Dow Corning adhesive in the particular context of attaching a basketball backboard to a basketball frame.

In addition, the Board stated that Hying disclosed "a known prior basketball backboard construction wherein a double-sided adhesive layer 5 is used to secure an acrylic backboard 3 to a welded steel frame 1" and also stated that Hying criticized that particular design.¹⁴ Nevertheless, the Board held that it was not obvious to use any particular adhesive to attach a basketball backboard to a basketball frame -- without any guidance to pick a particular adhesive:

In a nutshell, ***the examiner appears to take the position that it would have been obvious to try any number of prior art adhesives until one possibly arrived at a successful result where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful.*** However, ***this is not the standard*** of 35 U.S.C. § 103.¹⁵

¹³ See *Ex Parte Stevens*, at 6-7 (emphasis added).

¹⁴ See *Ex Parte Stevens*, at 4-5 (footnote omitted).

¹⁵ See *Ex Parte Stevens*, at 6-7 (citations omitted) (emphasis added).

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The Final Office Action dated February 9, 2006 also fails to cite any references that teach, suggest or disclose using a particular adhesive in the relevant context of attaching a basketball backboard to a basketball frame. Thus, the reasoning of the Board also applies to the currently cited references. For example, the Chung, Hankele, and Skedleski patents, and the Dow Corning datasheet, either alone or in combination, do not teach, suggest, or disclose to one of ordinary skill in the art to attach a basketball backboard to a basketball frame in any manner (and certainly not with any particular adhesive).

Additionally, although the Dow Corning datasheet states that its adhesive is “[d]eveloped for a variety of high technology bonding, sealing and encapsulating applications,” the Dow Corning datasheet never recommends, suggests, teaches, or describes attaching a basketball backboard to a basketball frame as a particular use. Further, the Dow Corning datasheet never even mentions the sport of basketball. Thus, as the Board has already decided, the Dow Corning datasheet does not provide any teaching, suggestion, or motivation for attaching a basketball backboard to a basketball frame and, thus, cannot be properly be combined with basketball backboard prior art.¹⁶

Also, the Office Action assumes that the Applicant has simply used an adhesive in the manufacturer’s “recommended way.” With this assumption, the Office Action expresses concern that “[i]f one were to follow this logic to its natural end, the sales representative for the acrylic adhesive should be added to the inventors of the application since he/she brought necessary knowledge to the inventive process.” The Office Action’s assumption is false because the Dow Corning datasheet does not recommend using its adhesive to attach a basketball backboard and

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basketball frame.

The Office Action allows improperly relies on impermissible hindsight to assert that the claimed invention is obvious. The Office Action states “The applicant also admits that the use of double side tape was inadequate in that it was costly and time consuming.” The Office Action then reasons: “A workman in the art in view of this deficiency would have looked for other equivalent but better means of attachment in the adhesive art.” However, as explained by the Applicant in the application, **the double-side tape is deficient when compared to the Applicant’s invention**.¹⁷ The MPEP, however, prevents such hindsight analysis: “The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” MPEP § 2141. Because the Office Action necessarily relies upon a hindsight comparison of the claimed invention to the prior art, Applicant requests that this Section 103(a) rejection be reversed by the Board.

Sub-Issue (b): Whether Claims 7-13 and 16-18 are unpatentable under 35 U.S.C. § 103(a) over applicant’s admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093 in view of Official Notice.

Applicant submits that this Section 103(a) rejection should be withdrawn for at least same reasons discussed above with respect to Issue 1 and Issue 2, Sub-Issue (a) above. In addition, this rejection should be withdrawn because none of the cited references, either alone or in combination,

¹⁶ See *Ex Parte Stevens*, at 6-7.

¹⁷ cf. Ward Decl. ¶ 11 (August 31, 2001) (discussing material cost savings); Ward Decl. ¶ 12 (August 31, 2001) (discuss labor time/cost savings).

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teach, suggest or disclose each and every limitation of Claims 7-13 and 16-18. For example, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use bond gap spacers in the context of basketball backboards and basketball backboard frames. See Claims 7 and 14. Moreover, this rejection should be withdrawn because the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the particularly claimed bond gap spacers in this context. See Claims 8-10 and 16-18. In addition, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the claimed “catalyzed elastomeric adhesive” of Claim 1 in contexts where “the backboard frame structure is constructed from metal” (Claim 11); where “the backboard frame structure is painted metal” (Claim 12); or where “the backboard bonding surface contains a printed image” (Claim 13). In sum, this Section 103(a) rejection should be reversed by the Board.

Sub-Issue (c): **Whether Claims 44 and 45 are unpatentable under 35 U.S.C. § 103(a) over applicant’s admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedelecki, et al.; and Dow Corning Data Sheet Q3-6093.**

Applicant submits that this Section 103(a) rejection should be withdrawn for at least same reasons discussed above with respect to Issue 1 and Issue 2, Sub-Issue (a) above. In addition, this rejection should be withdrawn because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 44 and 45. For example, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use “a catalyzed silicone-based adhesive” in the context of connecting basketball backboards and basketball

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backboard frames. See Claim 44. Moreover, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the “catalyzed silicone-based adhesive” of Claim 44 where “the basketball backboard frame is constructed from metal” as recited in Claim 45. Thus, this Section 103(a) rejection should be reversed by the Board.

Sub-Issue (d): **Whether Claims 46 and 47 are unpatentable under 35 U.S.C. § 103(a) over applicant’s admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.**

Applicant submits that this Section 103(a) rejection should be withdrawn for at least same reasons discussed above with respect to Issue 1 and Issue 2, Sub-Issue (a) above. In addition, this rejection should be withdrawn because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 46 and 47. For example, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use “a catalyzed elastomeric adhesive” in the context of connecting basketball backboards and basketball backboard frames. See Claim 46. Moreover, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the “catalyzed elastomeric adhesive” of Claim 46 where “the basketball backboard is constructed from acrylic” as recited in Claim 47. Accordingly, this Section 103(a) rejection should be reversed by the Board.

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Sub-Issue (e): Whether Claims 48 and 49 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.

Applicant submits that this Section 103(a) rejection should be withdrawn for at least same reasons discussed above with respect to Issue 1 and Issue 2, Sub-Issue (a) above. In addition, this rejection should be withdrawn because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 48 and 49. For example, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use "a catalyzed elastomeric adhesive" in the context of connecting basketball backboards and basketball backboard frames. See Claim 48. Moreover, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the "catalyzed elastomeric adhesive" of Claim 48 where "the basketball backboard is constructed from acrylic" as recited in Claim 49. Consequently, this Section 103(a) rejection should be reversed by the Board.

Sub-Issue (f): Whether Claims 50 and 51 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.

Applicant submits that this Section 103(a) rejection should be withdrawn for at least same reasons discussed above with respect to Issue 1 and Issue 2, Sub-Issue (a) above. In addition, this rejection should be withdrawn because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 50 and 51. For example, the Office

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Action fails to cite any reference providing a teaching, suggestion or motivation to use “a silicone-based adhesive” in the context of connecting basketball backboards and basketball backboard frames. See Claim 50. Moreover, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the “silicone-based adhesive” of Claim 50 where “the basketball backboard is constructed from acrylic” as recited in Claim 51. In sum, this Section 103(a) rejection should be reversed by the Board.

Sub-Issue (g): **Whether Claims 52 and 53 are unpatentable under 35 U.S.C. § 103(a) over applicant’s admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093.**

Applicant submits that this Section 103(a) rejection should be withdrawn for at least same reasons discussed above with respect to Issue 1 and Issue 2, Sub-Issue (a) above. In addition, this rejection should be withdrawn because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 52 and 53. For example, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use “a silicone-based adhesive” in the context of connecting basketball backboards and basketball backboard frames. See Claim 52. Moreover, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the “silicone-based adhesive” of Claim 52 where “the basketball backboard is constructed from acrylic” as recited in Claim 53. In addition, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use bond gap spacers in the context of basketball backboards and basketball backboard frames. See Claim 52.

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Therefore, Claims 52 and 53 are not unpatentable under Section 103(a) and this rejection by the examiner should be reversed by the Board.

Sub-Issue (h): Whether Claims 50-53 are unpatentable under 35 U.S.C. § 103(a) over applicant's admitted prior art in view of Ichemco.

Applicant submits that this Section 103(a) rejection should be withdrawn for at least same reasons discussed above with respect to Issue 1 and Issue 2, Sub-Issue (a) above. In addition, this rejection should be withdrawn because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 50-53. For example, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use “a silicone-based adhesive” in the context of connecting basketball backboards and basketball backboard frames. See Claims 50 and 52. Moreover, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use the “silicone-based adhesive” of Claims 50 and 52 where “the basketball backboard is constructed from acrylic” as recited in Claims 51 and 53. In addition, the Office Action fails to cite any reference providing a teaching, suggestion or motivation to use bond gap spacers in the context of basketball backboards and basketball backboard frames. See Claim 52. Therefore, Claims 50-53 are patentable under Section 103(a) and this rejection by the examiner should be reversed by the Board.

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CONCLUSION

As a final point, Appellant notes that while not every contention, allegation and characterization of the Examiner set forth in the Final Office Action, or raised at any other time during the prosecution of this case, was specifically addressed herein, the lack of remarks concerning any particular contention, allegation or characterization advanced by the Examiner is not intended, and should not be construed, to constitute an admission or concession by Appellant.

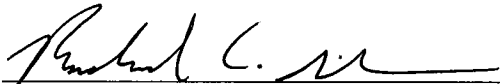
For at least the reasons discussed herein, Appellant respectfully submits that the Examiner's rejections of the claims are not well taken. Accordingly, Appellant requests that the Board reverse the Examiner's rejections of Claims 1, 2, 5-18 and 44-53.

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The Commissioner is authorized to charge payment of any additional fees associated with this communication, which have not otherwise been paid, to Deposit Account No. 23-3178. If any additional extension of time is required, which have not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

Respectfully submitted,

Dated: January 9, 2002

By: 

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Claims Appendix

1. A basketball backboard assembly that is sized and configured for playing the game of basketball, the basketball backboard assembly comprising:

a basketball backboard frame structure having a bonding surface;

an acrylic basketball backboard having a bonding surface; and

a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.

2. A basketball backboard assembly as in Claim 1, wherein the elastomeric adhesive has a bond gap in the range from about 2 to 2.5 mm (0.08 to 0.1 inch).

3. (Cancelled)

4. (Cancelled)

5. A basketball backboard assembly as in Claim 1, wherein the elastomeric adhesive is a two-part catalyzed adhesive in which the two parts are combined in a ratio to provide a set time in the range from about 7 to 15 minutes.

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6. A basketball backboard assembly as in Claim 1, wherein the elastomeric adhesive is a two-part catalyzed adhesive in which the two parts are combined in a ratio to provide a set time in the range from about 5 minutes to 1 hour.

7. A basketball backboard assembly as in Claim 1, further comprising one or more bond gap spacers located between the frame bonding surface and the backboard bonding surface to provide a defined bond gap.

8. A basketball backboard assembly as in Claim 7, wherein the one or more bond gap spacers comprise spherical beads.

9. A basketball backboard assembly as in Claim 7, wherein the one or more bond gap spacers comprise glass microspheres.

10. A basketball backboard assembly as in Claim 7, wherein the one or more bond gap spacers comprise glass microspheres that have a diameter in the range from about 2 to 2.5 mm (0.08 to 0.1 inch).

11. A basketball backboard assembly as in Claim 1, wherein the backboard frame structure is constructed from metal.

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12. A basketball backboard assembly as in Claim 1, wherein the backboard frame structure is painted metal.

13. A basketball backboard assembly as in Claim 1, wherein the backboard bonding surface contains a printed image.

14. A basketball backboard assembly that is sized and configured for playing the game of basketball, the basketball backboard assembly comprising:

a metal basketball backboard frame structure having a bonding surface;

an acrylic basketball backboard having a bonding surface;

a catalyzed silicone adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the silicone adhesive is configured to provide a set time in the range from about 5 minutes to 1 hour, wherein the silicone adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball; and

one or more bond gap spacers located between the frame bonding surface and the backboard bonding surface to provide the bond gap.

15. A basketball backboard assembly as in Claim 14, wherein the silicone adhesive is configured to provide a set time in the range from about 7 to 15 minutes.

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16. A basketball backboard assembly as in Claim 14, wherein the one or more bond gap spacers comprise spherical beads.

17. A basketball backboard assembly as in Claim 14, wherein the one or more bond gap spacers comprise glass microspheres.

18. A basketball backboard assembly as in Claim 14, wherein the one or more bond gap spacers comprise glass microspheres that have a diameter in the range from about 2 to 2.5 mm (0.08 to 0.1 inch).

Claims 19-43 (Cancelled).

44. A basketball backboard assembly comprising:
a basketball backboard frame;
a basketball backboard constructed from acrylic; and
a catalyzed silicone-based adhesive connecting the basketball backboard and the basketball backboard frame and positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame.

45. A basketball backboard assembly as in Claim 44, wherein the basketball backboard frame is constructed from metal.

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46. A basketball backboard assembly comprising:

a basketball backboard frame;

a basketball backboard; and

a catalyzed elastomeric adhesive connecting the basketball backboard and the basketball backboard frame and positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame.

47. A basketball backboard assembly as in Claim 46, wherein the basketball backboard is constructed from acrylic.

48. A basketball backboard assembly comprising:

a basketball backboard frame;

a basketball backboard; and

a catalyzed elastomeric adhesive connecting the basketball backboard and the basketball backboard frame and positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame.

49. A basketball backboard assembly as in Claim 48, wherein the basketball backboard is constructed from acrylic.

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50. A basketball backboard assembly comprising:

a basketball backboard frame;

a basketball backboard; and

a silicone-based adhesive connecting the basketball backboard and the basketball backboard frame and positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame.

51. A basketball backboard assembly as in Claim 50, wherein the basketball backboard is constructed from acrylic.

52. A basketball backboard assembly comprising:

a basketball backboard frame;

a basketball backboard;

a silicone-based adhesive connecting the basketball backboard and the basketball backboard frame and positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame; and

one or more bond gap spacers positioned between at least a portion of the basketball backboard and at least a portion of the basketball backboard frame to provide a defined bond gap.

53. A basketball backboard assembly as in Claim 52, wherein the basketball backboard is

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constructed from acrylic.

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Related Proceedings Appendix

This application, serial no. 09/228,325, was the subject of Appeal No. 2002-0980, which was heard on February 19, 2003 and a decision was rendered on March 27, 2003. The Board reversed the decision of the examiner finally rejecting the appealed claims.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LARRY STEVENS

Appeal No. 2002-0980
Application No. 09/228,325

HEARD: February 19, 2003

MAILED

MAR 27 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2 and 4-18, all the claims currently pending in the application.

The Invention

Appellant's invention pertains to a basketball backboard assembly. As explained on page 2 of appellant's specification, it is known in the art to use a two-sided tape having a foam core to secure an acrylic backboard to a backboard frame assembly. Appellant

asserts, however, that the use of two-sided tape is not altogether satisfactory because it is time and labor intensive. In an effort to resolve this problem, appellant utilizes a catalyzed elastomeric adhesive in place of the conventional two-sided tape. According to appellant (specification, page 3), the application of catalyzed elastomeric adhesive may be automated and performed by commercially available robotic equipment, thereby improving the efficiency and cost of assembly, while at the same time allowing the cure time to be customized to provide an optimum time set.

Claim 1 is exemplary of the appealed subject matter, and reads as follows (with emphasis added):

1. A basketball backboard assembly sized and configured for playing the game of basketball comprising:

a backboard frame structure having a bonding surface;

an acrylic backboard having a bonding surface; and

a *catalyzed elastomeric adhesive* sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball.

The Prior Art

The following references have been cited by the examiner as evidence of obviousness:^{1,2}

Nunes ³	5,677,896	Oct. 14, 1997
Hying et al. (Hying)	5,839,982	Nov. 24, 1998

Information About Specialty Materials for High Technology Applications, Dow Corning® Q3-6093 Silicone Adhesive, copyright 1987 (hereinafter, Dow Corning)⁴

3M™ Microspheres Performance Enhancements (http://www.3m.com/market/industrial/additives/perfen_1.html) and 3M™ Microspheres Application-Market Matrix (<http://www.3m.com/market/industrial/additives/appguide.html>) (collectively, 3M)

¹The publication date of the Dow Corning and 3M references has not been established; however, appellant does not dispute that they are prior art with respect to the claimed invention.

²The list of references relied upon in the examiner's answer also included US Patent 4,951,179 to Machida. In that this reference is not included in the statement of either of the examiner's rejections, its listing is presumed to be in error.

³This reference apparently was inadvertently omitted from the list of references relied upon on page 2 of the answer.

⁴Although the list of references relied upon on page 2 of the answer identifies this reference as "GE data sheet," it is clear from the explanation of the rejections in the final rejection and answer that the reference intended is the noted Dow Corning publication. In any event, whether the reference intended is Dow Corning or one of the several General Electric publication of record in this application, our decision in this appeal would be the same. This is so because the Dow Corning and General Electric publications are cited for essentially the same purpose, namely, to establish that catalyzed elastomeric silicone adhesives were known in the art at the time of appellant's invention, a fact acknowledged by appellant on page 5 of the specification.

LJS/lp

The Rejections

Claim 1 stands rejected 35 U.S.C. § 103 as being unpatentable over Hying in view of Dow Corning.

Claims 2 and 4-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hying in view of Dow Corning and further in view of Nunes and 3M.

Reference is made to appellant's main and briefs (Paper Nos. 16 and 20) and to the examiner's final rejection and answer (Paper Nos. 9 and 17) for the respective positions of appellant and the examiner regarding the merits of these rejections. Appellant also relies upon the declaration of Jerry Ward and the declaration of S. Curtis Nye in support of the position that the appealed claims are patentable over the applied references.

The Examiner's Position

Looking first at the rejection of claim 1, Hying pertains, in pertinent part, to a basketball backboard assembly comprising a backboard frame structure, and an acrylic backboard supported thereon. In the background section of the specification, Hying describes at column 1, lines 10-35, a known prior basketball backboard construction wherein a double-sided adhesive layer 5 is used to secure an acrylic backboard 3 to a

welded steel frame 1.⁵ According to Hying, this type of backboard construction suffers from a number of disadvantages, including insufficient strength of the adhesive to retain the acrylic backboard against the frame (column 2, lines 27-29) and exposure of the edges of the acrylic backboard, which edges are susceptible to cracking when struck by a ball or other object (column 2, lines 32-36). Hying's solution is to replace the double-sided adhesive with an extruded plastic channel member 13 for connecting the backboard to the backboard frame. In addition to connecting the backboard to the backboard frame, the channel member envelopes the backboard edges to thereby protect them from damage.

In rejecting claim 1, it appears that the starting point of the examiner's rejection is Hying's prior art double-sided adhesive layer backboard construction. The examiner concedes that this prior art construction does not use a catalyzed elastomeric adhesive to secure the backboard to the backboard frame as set forth in claim 1. The examiner relies on Dow Corning for a teaching that catalyzed elastomeric adhesives were known *per se* at the time of appellant's invention. According to the examiner, it would have been obvious to one of ordinary skill in the art to have employed the elastomeric adhesive of the Dow Corning to attach the backboard of Hying to the frame, the motivation being "to prevent injury to the players if the attachment means failed and to take advantage of their

⁵This known basketball backboard construction would appear to correspond to the prior art basketball backboard described on page 2, lines 3-8, of appellant's specification that the present invention seeks to improve upon.

desirable properties over wide temperature ranges" (answer, page 3). In the "Response to Arguments" section of the answer, the examiner further states:

[T]he Hying patent notes that [it] is old to use adhesives to bond the backboard to the support structure. The adhesive claimed is common and well known. It would be an obvious choice for one of ordinary skill in the art to use a readily available adhesive in the attachment of the backboard to the support. [Answer, page 7.]

Discussion

The initial burden is on the examiner to present evidence from which it can be concluded that a *prima facie* case of obviousness has been established. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Once a *prima facie* case has been established, the burden of going forward shifts to appellant. In the present case, it is our view that the examiner has not met his initial burden. Our reasons follow.

Like appellant, we find no teaching, suggestion, or inference in the combined teachings of the applied references that would have led the ordinarily skilled artisan to utilize the adhesive of Dow Corning to secure the acrylic backboard of Hying to the

backboard frame, as proposed by the examiner. The examiner's position to the effect that it would have been an "obvious choice" for one of ordinary skill in the art to use any readily available and suitable adhesive, and in particular the adhesive of Dow Corning, as a replacement for Hying's double-sided adhesive is without foundation in the absence of evidence supporting such a contention. More particularly, the examiner has not pointed out where the applied references teach that using Dow Corning's adhesive in Hying's environment would "prevent injury to the player," and/or precisely what "properties over wide temperature ranges" Dow Corning's adhesive possesses that the one of ordinary skill in the art would have found to be "desirable" in Hying's environment. In a nutshell, the examiner appears to take the position that it would have been obvious to try any number of prior art adhesives until one possibly arrived at a successful result where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful. However, this not the standard of 35 U.S.C. § 103. See *In re Goodwin*, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977); *In re Tomlinson*, 363 F.2d 928, 931, 150 USPQ 623, 626 (CCPA 1966).

We also note that at various places in the answer (e.g., paragraph spanning pages 3-4) the examiner indicates that the particular adhesive utilized by appellant would have been an obvious matter of design choice in the absence of a showing of criticality. We do not agree with this position. In specifically disclosing the type of adhesive used in the invention, appellant has made clear that this adhesive has been chosen for its excellent adhesive and flexibility, controllable cure time, and adaptability to automated assembly (specification, pages 2-4). Far from being matters of obvious design choice, these matters are at the very heart of appellant's disclosed and claimed invention. The examiner cannot simply brush such features aside.

Under these circumstances, we conclude that the examiner has not established a *prima facie* case of obviousness of claim 1.

Turning to the rejection of claims 2 and 4-18 as being unpatentable over Hying in view of Dow Corning and further in view of Nunes and 3M, we have considered the Nunes and 3M additionally applied in this rejection but find nothing therein that makes up for the deficiencies of Hying and Dow Corning discussed above. Accordingly, the examiner also has not established a *prima facie* case of obviousness of these claims.

Regarding the declarations of Jerry Ward and S. Curtis Nye proffered by appellant in support of the patentability of the appealed claims, in that the examiner has not

established a *prima facie* case of obviousness, it is unnecessary for us to consider appellant's evidence of nonobviousness.

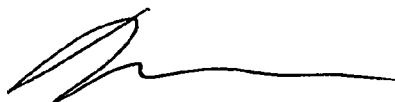
Conclusion

The rejection of claim 1 as being unpatentable over Hying in view of Dow Corning is reversed.

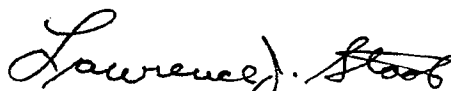
The rejection of claims 2 and 4-18 as being unpatentable over Hying in view of Dow Corning, Nunes and 3M is reversed.

The decision of the examiner finally rejecting the appealed claims is reversed.

REVERSED



NEAL E. ABRAMS
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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